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UNITED STATES PATENT AND TRADEMARK OFFICE

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Appl. no. 09/681,645

Examiner Name: CHANG, ERIC

Group Art Unit: 2116

Confirmation Number: 8737

Attorney Docket Number: ERLGP008US

REQUEST FOR CANCELATION OF OFFICE ACTION

June 2, 2004 IDS “Mullins” not considered by the Examiner. The undersigned also electronically filed an Information Disclosure Statement on June 2, 2004, listing eleven references, the first of which was a reference Mullins. This IDS appears in IFW.

June 24, 2004 IDS “Coffey” not considered by the Examiner. The undersigned also electronically filed an Information Disclosure Statement on June 24, 2004, listing two references, the first of which was a reference Coffey. This IDS appears in IFW.

June 28, 2004 Preliminary Amendment not considered by the Examiner. The undersigned filed a Preliminary Amendment on June 28, 2004, canceling claims 1-6 and adding new claims 7-13. The Preliminary Amendment also addressed a docket number at page 4, line 3. The Preliminary Amendment is listed in Palm and in PAIR and it appears in the Image File Wrapper (IFW) system.

July 7, 2004 IDS “Tobita” not considered by the Examiner. The undersigned also fax-filed an Information Disclosure Statement on July 7, 2004, listing eight references, the first of which was a reference Tobita. This IDS appears in IFW.

On August 24, 2004 the Examiner mailed an Office Action. The Office Action rejected claims 1-6, a rejection that was inappropriate given that they had been canceled some seven weeks earlier. The Office Action did not examine the claims actually pending in the application, namely claims 7-14. The Office Action did not consider the “Mullins”

IDS, the "Coffey" IDS, or the "Tobita" IDS.

The Office Action found fault with the docket number at page 3, line 3, which was inappropriate given that the docket number had been addressed in the June 28, 2004 Preliminary Amendment.

The Office Action must be canceled. Under 37 CFR section 1.702(a)(1), the USPTO delay of more than fourteen months from the filing date (May 15, 2001) and the mailing of the first office action is considered in calculating the Patent Term Adjustment (PTA). It would be inequitable if this purported Office Action, dated August 24, 2004, were to count as a *bona fide* Office Action. The Office Action must be canceled.

A new Office Action, considering for the first time the June 28, 2004 Preliminary Amendment and the three Information Disclosure Statements not yet considered, should be mailed.

REMARKS

The undersigned offers the following comments regarding US pat. 5,475,295 to Hong ("Hong") and US pat. 6,553,500 to Sterzik et al. ("Sterzik").

A brief discussion of Hong is instructive.

Hong has a "main body" (Fig. 1A) and a "remote controller" (Fig. 1B). The remote controller can generate a wireless signal by its light-emitting diode LD2 which is received at the main body at phototransistor 20. In response to the signal, the main body uses circuitry 12 to test a voltage at battery 11. The results of the test are transmitted by the main body by its light-emitting diode LD1 and are received at phototransistor 40.

The undersigned is unable to find, anywhere in Hong, a "backplane" nor is it possible to

find in Hong a plurality of "devices" communicating by the backplane.

So far as the undersigned can discern, nowhere in Hong is there any step of information storage. Indeed the word "memory" cannot be found in Hong. Thus there is no storage of values relating to signals indicative of output voltages, no storage of scaling values, and no storage of power supply unit serial numbers.

So far as the undersigned can discern, nowhere in Hong is there any mention of power supply unit serial numbers or any other type of serial numbers. Indeed the word "serial" or "serial number" cannot be found in Hong.

So far as the undersigned can discern, nowhere in Hong is there any mention of scaling factors. Indeed the words "scaling" and "factor" cannot be found in Hong. The disclosure of Hong seems to make clear that the measurement of voltage by circuitry 12 is done in a way that is always the same – there seems to be no "scaling factor" for the measurement. Hong teaches an output that takes any of five possible values – 1111, 0111, 0011, 0001, and 0000. (This encoding is bit-wise inefficient, by the way, as it consumes four bits to communicate a mere five possible values. Three bits would have sufficed.) Nothing about the Hong disclosure hints at or suggests the availability of any scaling factor for this measurement. Stating this point differently, a value of, say, "0111" always corresponds to some particular voltage and the "resolution" (voltage difference between adjacent values) is always the same with Hong.

It is anticipated that the Examiner, in attempting to read the claims onto the disclosure of Hong, might suggest that the "devices" of the claims are the "remote controller" and that the "controller" of the claims is the "main body."

Such a reading would overlook that all of the claims are limited in that there is not merely one "device;" instead there is a "plurality of devices." For such a reading onto Hong to succeed, there would thus apparently need to be a plurality of remote controllers all

communicating with the main body. But Hong teaches away from such a reading, always referring to a remote controller in the singular. What's more, it appears to the undersigned that if one were to attempt to modify Hong by adding additional remote controllers, the resulting system would be failure-prone. Nothing in Hong addresses what would happen if users were to press buttons on two or more controllers at overlapping times. Collisions would result and messages would get garbled and lost. One skilled in the art in the field of Hong would know not to try to provide two or more controllers as they would conflict. One skilled in the art in the field of the claimed invention, where there are multiple devices communicating by means of a backplane, would not turn to the remote-control art of Hong where the use of two or more controllers would conflict.

It is anticipated that in an effort to supply some of the claim limitations that are missing from Hong, the Examiner might turn to Sterzik. But the undersigned is not able to find anywhere in Sterzik where any of the missing limitations can actually be found. Sterzik does not, for example, contain scaling factors or serial numbers.

Any attempt to combine Hong and Sterzik would present another problem, namely that Hong has to do with battery-powered remote controllers and Sterzik has to do with computer power supplies. One skilled in the art of computer power supplies would not, it is suggested, turn to the art of battery-powered remote controllers.

The undersigned is also unable to find in either reference a scaling value or a power supply unit serial number, as well as storing a value associated with an output supply level, and storing a scaling value, and storing a power supply unit serial number. Indeed the words "scaling" and "factor" cannot be found in Hong. The undersigned is likewise unable to find a serial number in Hong or in Sterzik.

In Hong, the monitoring circuitry is circuitry which (so far as the undersigned can discern) is powered by the very battery that is being monitored. This differs from claim 13, in which the controller of the claim is able to draw power from the backplane and thus

from a source other than the associated power supply unit.

Conclusion. It is requested that the Office Action be canceled and a new Office Action be mailed, taking into account the Preliminary Amendment and the three not-yet-considered IDSs.

Respectfully submitted,

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